

Application No.: 09/202,681

7

Docket No.: 564462001001

REMARKS**Telephonic interview of June 14, 2005**

Applicants thank the Examiner for the courteous and helpful telephonic interview of June 14, 2005, regarding the Advisory Action mailed June 03, 2005, and issues raised by the Patent Office in that communication. Applicants have endeavored to address those issues in this RCE amendment and response, as discussed, below.

Advisory Action of June 03, 2005

In the Advisory Action mailed June 03, 2005, the Office acknowledged Applicants' arguments of April 18, 2005; however, the proposed claim amendments in that response were not entered because, it was alleged, the proposed claim amendments would raise new issues that require further consideration and/or search. The instant amendment addresses the Office's concerns.

First, claim 18 is amended such that its scope clearly differs from that of claim 19; support for this amendment is noted below.

Second, as suggested by the office, in claim 10 the word "a" is replaced with the word "the".

Lastly, please note that support for claims directed to host cells comprising a polypeptide of the invention can be found, inter alia, on page 3, lines 6 to 20, of the specification, where the disclosure discusses cells comprising a polypeptide of the invention.

Advisory Action of March 29, 2005

In the Advisory Action mailed March 29, 2005, the Office acknowledged Applicants' arguments; however, the proposed claim amendments in that response were not entered because claim 18 (dependent on, or drawn to, the polypeptide of claim 10) has a limitation wherein an enzymatically active fragment of the polypeptide is at least 30 amino acids in length - and claim 10 does not have such a limitation. The responding amendment addressed that issue - claim 18 as amended is dependent on claim 11 (rather than claim 10).

sd-265217

Application No.: 09/202,681

8

Docket No.: 564462001001

Status of the Claims*Pending claims*

Claims 1 to 11, 13 to 21 and 31 to 52 are pending.

Because Applicants' proposed amendments of April 18, 2005, March 11, 2005, and January 13, 2005, were not entered (see Advisory Actions mailed March 29, 2005, and February 23, 2005 noting the Office considered Applicants' remarks in those submissions), the instant claim listing and amendments are based on the last entered claim amendment, i.e., the response and amendment submitted by Applicants on May 18, 2004.

Claims canceled and added in the instant amendment

In the present response, claims 5 to 7, 13 to 17, 20, 21, 31 to 36 and 41 to 47 are canceled without prejudice or disclaimer, and new claims 53 to 56 are added. Accordingly, after entry of the instant amendment, claims 1 to 4, 8 to 11, 18, 19, 37 to 40 and 48 to 56, will be pending and under examination.

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

Rejected claims were amended to be dependent on allowed claims or incorporate the limitations of allowed claims. Claims dependent on only allowed claims were not canceled.

Allowed claims

Applicants thank the Examiner for finding claims 1, 2 and 48 to 52 allowable.

Outstanding Objections and Rejections

In the final office action mailed August 13, 2004, the Patent Office maintained the rejection of claims 15 to 17, 20, 21 and 41 to 43 under 35 U.S.C. §112, first paragraph, written

sd-265217

Application No.: 09/202,681

9

Docket No.: 564462001001

description requirement. The Office maintained the rejection of claims 3 to 5, 10, 11, 13 to 21 and 31 to 44 under 35 U.S.C. §112, first paragraph, enablement requirement.

Applicants respectfully traverse all outstanding objections to the specification and claims and rejections of the claims.

Support for the Claim Amendments

Support for the claim amendments can be found throughout the specification. Support for claims directed to host cells comprising a polypeptide of the invention can be found, inter alia, on page 3, lines 6 to 20, of the specification, where the disclosure discusses cells comprising a polypeptide of the invention. Support for claims directed to purified polypeptides of the invention can also be found, inter alia, on page 3, lines 6 to 20, of the specification. Accordingly, Applicants respectfully submit that no new matter is introduced by the instant amendments.

Issues under 35 U.S.C. §112, first paragraph

Written Description

The Patent Office maintained the rejection of claims 15 to 17, 20, 21 and 41 to 43 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors at the time the application was filed had possession of the claimed invention.

Applicants respectfully submit that the claimed invention is sufficiently described in the specification such that one of ordinary skill in the art would be able to ascertain the scope of the claims with reasonable clarity and recognize that Applicants' were in possession of the claimed invention at the time of filing for reasons set forth in Applicants previous responses, which are expressly incorporated herein. Applicants respectfully submit that describing a genus of polynucleotides in terms of physico-chemical properties (e.g., a % sequence identity or stringent hybridization to the exemplary SEQ ID NO:19 or nucleic acids encoding SEQ ID NO:28) and function (e.g., encoding a polypeptide having phosphatase activity) satisfies the written description requirement of section 112, first paragraph.

sd-265217

Application No.: 09/202,681

10

Docket No.: 564462001001

However, merely to expedite prosecution and allowance of this application, rejected claims are amended to be dependent on allowed claims or incorporate the limitations of allowed claims, or canceled without prejudice or disclaimer (claims dependent on only allowed claims were not canceled).

In light of the above remarks, Applicants respectfully submit that the amended claims are sufficiently described in the specification to overcome the 35 U.S.C. §112, first paragraph, written description rejection.

Enablement

The Patent Office maintained the rejection of claims 3 to 5, 10, 11, 13 to 21 and 31 to 44 under 35 U.S.C. §112, first paragraph, as allegedly not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. The Patent Office states that the specification is enabling for polynucleotides which encode the amino acid sequence of SEQ ID NO:28 or enzymatically active fragments thereof.

Applicants respectfully aver that the specification enabled the skilled artisan at the time of the invention to identify, and make and use, the genus of phosphatase-encoding nucleic acids and phosphatases of the claimed invention for reasons set forth in Applicants previous responses, which are expressly incorporated herein.

However, merely to expedite prosecution and allowance of this application, rejected claims are amended to be dependent on allowed claims or incorporate the limitations of allowed claims, or canceled without prejudice or disclaimer (claims dependent on only allowed claims were not canceled).

Applicants respectfully submit that the pending claims meet the enablement requirement under 35 U.S.C. §112, first paragraph. In light of the above remarks, Applicants respectfully submit that the specification sufficiently described how to make and use the claimed methods to satisfy the requirements of 35 U.S.C. §112, first paragraph.

sd-265217

Application No.: 09/202,681

11

Docket No.: 564462001001

CONCLUSION

In view of the foregoing amendment and remarks, it is believed that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first paragraph. Applicants believe all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the event the U.S. Patent and Trademark office determines that additional fees and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462001001. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please call the undersigned at 858 720 5133.

Dated: June 14, 2005

Respectfully submitted,

By 

Gregory P. Elnhorn

Registration No.: 38,440

MORRISON & FOERSTER LLP

3811 Valley Centre Drive

Suite 500

San Diego, California 92130-2332

(858) 720-5133

sd-265217